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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,959	05/24/2001	Hiroyuki Watanabe	S004-4306	2869

40627                      7590                      06/15/2006

ADAMS & WILKS  
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EXAMINER

NGUYEN, TRI V

ART UNIT                      PAPER NUMBER

1751

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5

<b>Office Action Summary</b>	<b>Application No.</b> 09/864,959	<b>Applicant(s)</b> WATANABE ET AL.	
	<b>Examiner</b> Tri V. Nguyen	<b>Art Unit</b> 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 31 March 2006.
- 2a)  This action is FINAL.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 29-34 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 29-34 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a)  All    b)  Some \*    c)  None of:
    - 1.  Certified copies of the priority documents have been received.
    - 2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04/06.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. The amendment file on March 31, 2006 has been considered. Claims 1-28 have been cancelled. Claims 29-34 have been added. The currently pending claims considered below are Claims 29-34.

### *Claim Objections*

2. Claims 31 and 33 objected to because of the following informalities: Claims 31 and 33 recite "indentification" (claim 31, line 6 and claim 33, line 23); the Examiner notes the misspelling and interprets the claimed limitation as "identification." Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 32 recites in the preamble "an electronic coupon issuing system according to claim 31"; however, Claim 31 is a credit card settlement system.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

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(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 29-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Mankoff (US 2003/0028518).

Claim 29: Mankoff discloses a credit card settlement system comprising:

- a. electronic coupon registration means for registering electronic coupons associated with identification information on a credit card (page 5, parag 45 and pages 6-7, parag. 53-54);
- b. reception means for receiving from a credit card terminal, credit card settlement information including the identification information on the credit card (page 3, parag. 28-30);
- c. electronic coupon search means for searching the electronic coupons registered by the electronic coupon registration means for electronic coupons that are useable in connection with the identification information on the credit card (page 4-5, parag. 41);
- d. electronic coupon availability determination means for determining whether any of the electronic coupons searched by the electronic coupon search means is or is not available for credit card settlement by means of the credit card settlement information (page 3, parag. 28-30 and page 4-5, parag. 41);
- e. electronic coupon determination means for determining whether an electronic coupon determined to be available for credit card settlement by the electronic coupon availability determination means is or is not for a discount (page 3, parag. 28-30);
- f. discount means for giving a discount on a price for the credit card settlement when the electronic coupon is determined to be for a discount by the electronic coupon determination means (page 3, parag. 28-30); and
- g. license request transmission means for transmitting to a credit card settlement center a license request for the credit card settlement reflecting the price discounted by the discount means (page 3, parag. 28-30).

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Claim 30: Mankoff discloses a credit card settlement system according to claim 29; wherein the electronic coupon registration means comprises at least one of a mobile telephone, a computer connected to a network, and a digital broadcast reception terminal (page 3, parag. 28-30).

Claim 31: Mankoff discloses a credit card settlement system according to claim 29; further comprising an electronic coupon server

- a. having a database for storing the electronic coupons (page 3, parag. 28-30),
- b. receiving a request for acquisition of an electronic coupon from the electronic coupon registration means (page 3, parag. 28-30; page 3, parag. 28-30 and page 4-5, parag. 41), and
- c. storing the identification information on the credit card in correlation with the electronic coupon (page 3, parag. 28-30 and page 4, parag. 38-40).

Claim 32: Mankoff discloses an electronic coupon issuing system according to claim 31; wherein the electronic coupon server accumulates the search results of searches performed by the electronic coupon search means and accumulates electronic coupon usage information (page 4, parag. 38-40).

Claim 33: Mankoff discloses a credit card settlement system comprising:

- a. a credit card terminal for reading identification information on a credit card used in a credit card settlement (page 3, parag. 28-30);
- b. an electronic coupon server for storing information on electronic coupons associated with the identification information on the credit card (page 3, parag. 28-30); and
- c. a credit card settlement center for
  - i. transmitting to and receiving from a credit card company's server information on the credit card settlement (page 3, parag. 28-30 and page 4, parag. 36),
  - ii. receiving from the credit card terminal credit card settlement information including the identification information on the credit card (page 3, parag. 28-30 and page 4, parag. 35), and

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- iii. requesting the electronic coupon server to search for the electronic coupon associated with the identification information on the credit card;
  1. wherein the credit card settlement center comprises credit card settlement information reception means for receiving from the credit card terminal the credit card settlement information including the identification information on the credit card and registration information registered in advance in the credit card terminal, electronic coupon search condition transmission means for transmitting to the electronic coupon server the received identification information on the credit card and the registration information, electronic coupon search result reception means for receiving from the electronic coupon server the result information on the search for whether there is or is not an electronic coupon available for the credit card settlement and for a discount, and electronic coupon information transmission means for transmitting to the credit card terminal the information of the electronic coupon when the received result information on the search shows there is an electronic coupon available for the credit card settlement and for a discount (page 3, parag. 28-30; page 4-5, parag. 35, 38, 40 and 41);
  2. wherein the electronic coupon server comprises electronic coupon registration means for registering the electronic coupons associated with the identification information on the credit card, electronic coupon search condition reception means for receiving from the credit card settlement center the identification information on the credit card and the registration information, electronic coupon search means for searching for whether there is or is not a electronic coupon available for the credit card settlement in the electronic coupons registered by the electronic coupon registration means, electronic coupon availability determination means for determining whether the electronic coupon is or is not for a discount, when there is an electronic coupon available for the credit card settlement as a result of the search by the electronic coupon search

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means, and electronic coupon search result transmission means for transmitting to the credit card settlement center the information on the electronic coupon, when the available electronic coupon is for a discount as a result of the determination by the electronic coupon availability determination means (page 3, parag. 28-30; page 4-5, parag. 35, 38, 40 and 41); and

3. wherein the credit card terminal comprises reading means for reading the identification information on the credit card, credit card settlement information transmission means for transmitting to the credit card settlement center the credit card settlement information including the read identification information and the registration information, electronic coupon information reception means for receiving from the credit card settlement center the information on the electronic coupon available for the credit card settlement and for a discount, credit card settlement information recreation means for recreating the credit card settlement information reflecting the price discounted based on the information on the received electronic coupon, and discounted credit card settlement information transmission means for transmitting to the credit card settlement center the recreated credit card settlement information to request a license for the credit card settlement (page 3, parag. 28-30; page 4-5, parag. 35, 38, 40 and 41).

Claim 34: Mankoff discloses a credit card settlement system according to claim 29; wherein the electronic coupon registration means comprises at least one of a mobile telephone, a computer connected to a network, and a digital broadcast reception terminal (page 3, parag. 28-30).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 29-34 have been considered but are moot in view of the new ground(s) of rejection.

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**Conclusion**

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

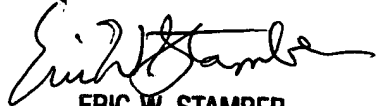
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029 and Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

nvt

  
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